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10/039,342	11/19/2001	Richard L. Borders	8266-0738	1486

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EXAMINER

TONG, NINA C

ART UNIT PAPER NUMBER

2632

DATE MAILED: 04/21/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/039,342

Applicant(s)

BORDERS ET AL.

Examiner

Nina Tong

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 05 January 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-57 is/are pending in the application.
- 4a) Of the above claim(s) 42-57 is/are withdrawn from consideration.
- 5) ☒ Claim(s) 12-17 is/are allowed.
- 6) ☒ Claim(s) 1-11 and 18-41 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 05 January 2004 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>4</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Election/Restrictions

1. Newly submitted claims 42-57 are directed to an invention that is independent or distinct from the invention originally claimed for the following reasons:

claims 1-41 (class 340/539.12) are related to the detail of the integrated device while claims 42-54 (class 340/573.1) are related to the communication and location tracking system for a facility and claims 55-57 (340/573.1) is a method of paging a staff member; The tracking system and the paging method could be using any well-known portable device while the integrated device could be used in any other environment. These inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification.

Since applicant has received an action on the merits for the originally presented invention, this invention has been constructively elected by original presentation for prosecution on the merits. Accordingly, claims 42-57 withdrawn from consideration as being directed to a non-elected invention. See 37 CFR 1.142(b) and MPEP § 821.03.

Incorporated by Reference

2. The attempt to incorporate subject matter into this application by reference to 08/963,396 and 08/960,425 are improper because the amendment in the specification must be accompanied by an affidavit or declaration executed by the applicant, or a practitioner representing the applicant, stating the amendatory material consists of the same material incorporated by

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reference in the referencing application. Also, both applications '396 and '425, are now abandoned. Reliance on a commonly assigned copending application by a different inventor may ordinarily be made for the purpose of completing the disclosure. The abandoned applications less than 20 years old can be incorporated by reference to the same extent as copending application.

The Examiner is not sure if the applications 08/963,396 and 08/960,425 and the present application are all having the common assignee with different inventors. The Examiner would be appreciate if the applicant could provide this information. Please see MPEP 608.01(p).

(note: if the support is from the original specification, please provides the detail information, such as the page and line numbers.)

Specification

3. The amendment in the specification and the drawings filed 01/05/04 is objected to under 35 U.S.C. 132 because it introduces new matter into the disclosure. 35 U.S.C. 132 states that no amendment shall introduce new matter into the disclosure of the invention. The added material which is not supported by the original disclosure is as follows: the detail of the specification amendment is not fully support by the original specification and if the amendment is from the incorporated reference; the applicant must provided an affidavit or declaration as mentioned above. However, since the Examiner is not sure if the amendment is same as the materials in the incorporated references to 08/963,396 and 08/960,425, the amendment in the specification and drawings are considered as new matters.

Applicant is required to cancel the new matter in the reply to this Office Action.

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 1-6,9-10,18-34,38-41, are rejected under 35 U.S.C. 103(a) as being unpatentable over White et al. (6,353,413) in view of White (4,275,385).

Regarding claims 1,2,3,6,38, White et al. discloses a multi-function universal controller system, wherein the system shows an integrated personal communication and data entry device (UC 10 – pager/cellular phone & PDA/PC – col.3 lines 22-35) which comprises the portable housing (rectangular box) enclosing the controller (computer 70) coupled to the paging device (pager – col.3 lines 22-35) and the voice recording device (microphone 31 – col.3 lines 54-55), and the infrared transmitter (IR transmitter 36).

White et al. Fails to specify the claimed infrared transmitter transmit an unique identifying signal on a periodic basis.

However, it is well-known in the art of providing the infrared transmitter to transmit its unique identifying signal on a periodic bases for tracking and identifying purpose as shown by White '385. It would have been obvious to one of ordinary skill in the art at the time the invention was made to have the IR transmitter to transmit its unique identifying signal on a periodic bases in White et al. as taught by White '385 for providing the tracking and identifying function as desired and as obvious design choice.

Regarding claim 4, the claimed cellular telephone transceiver (col.3 line 28-29).

Regarding claim 5, the claimed radio transceiver for two-way communication (RF transceiver 72).

Regarding claims 9,10, White et al. fails to specify the claimed “record voice data only after inputting ID” & “record voice data only after inputting voice print information”. However, it is well-known in the art for the security purpose for inputting any kind of identification, such as ID, voice print information, before authorizing to use a device/system. Also, as long as the system is function the same, providing with or without the security function would not constitute an inventive step but an obvious design choice. It would have been obvious to one of ordinary skill in the art at the time the invention was made to employ the well-known security system, such as by inputting an ID or voice print information, before authorizing to use the device of White et al. for performing the same function as desired and for security purpose.

Regarding claims 18,19,20,21, White et al. fails to specify the claimed housing/pager is coupled to the caregiver’s wrist, or the claimed pager is coupled to the caregiver’s waist/neck. However, as long as the system/device is function the same, couple the device to any person’s wrist, waist or neck by any well-known attachment means would not constitute an inventive step but an obvious design choice. It would have been obvious to one of ordinary skill in the art at the time the invention was made to employ the device of White et al. with any well-known

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attachment means such that the device is coupled to any person's, such as the caregiver's, wrist, waist, or neck for convenience and for performing the same function as desired.

Regarding claim 22, White et al. fails to specify the claimed "flexible sterile sheath configured to surround the housing". However, as long as the system/device is function the same, employing various kind of housing material would not constitute an inventive step but an obvious design choice. It would have been obvious to one of ordinary skill in the art at the time the invention was made to employ any well-known housing material, such as the flexible sterile sheath configured to surround the housing, for the device of White et al. for performing the same function as desired and for providing a more safety and comfortable housing to be carried by the user.

Regarding claims 23,25,39, White et al. discloses a multi-function universal controller system, wherein the system shows an integrated personal communication and data entry device (UC 10 – pager/cellular phone & PDA/PC – col.3 lines 22-35) which comprises the portable housing (rectangular box) enclosing the controller (computer 70) coupled to the paging device (pager – col.3 lines 22-35) and the cellular telephone transceiver (cellular phone – col.3 lines 22-35), and infrared transmitter (36).

White et al. Fails to specify the claimed infrared transmitter transmit an unique identifying signal on a periodic basis.

However, it is well-known in the art of providing the infrared transmitter to transmit its unique identifying signal on a periodic bases for tracking and identifying purpose as shown by White '385. It would have been obvious to one of ordinary skill in the art at the time the invention was made to have the IR transmitter to transmit its unique identifying signal on a periodic bases in White et al. as taught by White '385 for providing the tracking and identifying function as desired and as obvious design choice.

Regarding claim 24, the claimed radio transceiver for two-way communication (RF transceiver 72).

Regarding claim 26, the claimed voice recording device (microphone 31 – col.3 lines 54-55).

Regarding claims 27,29,40, White et al. discloses a multi-function universal controller system, wherein the system shows an integrated personal communication and data entry device (UC 10 – pager/cellular phone & PDA/PC – col.3 lines 22-35) which comprises the portable housing (rectangular box) enclosing the controller (computer 70) coupled to the paging device (pager – col.3 lines 22-35) and the radio transceiver for two-way communication (RF transceiver 72), and IR transmitter (36).

White et al. Fails to specify the claimed infrared transmitter transmit an unique identifying signal on a periodic basis.

However, it is well-known in the art of providing the infrared transmitter to transmit its unique identifying signal on a periodic bases for tracking and identifying purpose as shown by White '385. It would have been obvious to one of ordinary skill in the art at the time the invention was made to have the IR transmitter to transmit its unique identifying signal on a periodic bases in White et al. as taught by White '385 for providing the tracking and identifying function as desired and as obvious design choice.

Regarding claim 28, the claimed cellular telephone transceiver (cellular phone col.3 lines 22-35).

Regarding claim 30, the claimed voice recording device (microphone 31 – col.3 lines 54-55).

Regarding claims 31,41, White et al. discloses a multi-function universal controller system, wherein the system shows an integrated personal communication and data entry device (UC 10 – pager/cellular phone & PDA/PC – col.3 lines 22-35) which comprises the portable housing (rectangular box) enclosing the controller (computer 70) coupled to the paging device (pager – col.3 lines 22-35) and the infrared transmitter (IR transmitter 36).

White et al. Fails to specify the claimed infrared transmitter transmit an unique identifying signal on a periodic basis.

However, it is well-known in the art of providing the infrared transmitter to transmit its unique identifying signal on a periodic bases for tracking and identifying purpose as shown by

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White '385. It would have been obvious to one of ordinary skill in the art at the time the invention was made to have the IR transmitter to transmit its unique identifying signal on a periodic bases in White et al. as taught by White '385 for providing the tracking and identifying function as desired and as obvious design choice.

Regarding claim 32, the claimed cellular telephone transceiver (cellular phone col.3 lines 22-35).

Regarding claim 33, the claimed radio transceiver for two-way communication (RF transceiver 72).

Regarding claim 34, the claimed voice recording device (microphone 31 – col.3 lines 54-55).

6. Claim 7 is rejected under 35 U.S.C. 103(a) as being unpatentable over White et al. (6,353,413) in view of White (4,275,385) as applied to claim 1 above, and further in view of Walters et al. (6,453,281).

Regarding claim 7, White et al. fails to specify the claimed “voice recording device is configured to digitize voice data and to transform the digitized voice data into computer readable

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text data”. However, it is well-known in the art of providing the speech/text converter as desired. It would have been obvious to one of ordinary skill in the art at the time the invention was made to employ the well-known speech/text converter in White et al. for converting the voice into text as taught by Walters et al. for convenience and for performing the same function as desired.

7. Claim 8 is rejected under 35 U.S.C. 103(a) as being unpatentable over White et al. (6,353,413) in view of White (4,275,385) as applied to claim 1 above, and further in view of Kita et al. (4,717,261).

Regarding claim 8, White et al. discloses a computer which inherently included a clock. White et al. fails to specify the claimed “record time and date corresponding to the recorded voice data”. It is well-known in the art of recording time and date corresponding to the recorded voice data for ensuring the timing of the recorded voice messages for convenience as taught by Kita et al.. It would have been obvious to one of ordinary skill in the art at the time the invention was made to employ the clock in the computer for recording the time and date corresponding the recorded voice data in White et al. as taught by Kita et al. for performing the same function as desired and for convenience and for ensuring the timing of the recorded voice messages.

8. Claim 11 is rejected under 35 U.S.C. 103(a) as being unpatentable over White et al. (6,353,413).

Regarding claim 11, White et al. fails to specify the claimed “transmit voice information over a wireless communication link to a hospital data system”. However, White et al. does show the function of wirelessly transmitting sound data to a remote location. As long as the system is function the same, transmitting the voice data to any remote location would not constitute an inventive step but an obvious design choice. It would have been obvious to one of ordinary skill in the art at the time the invention was made to transmit the voice data wirelessly to any remote location, such as the hospital data system, in White et al. for performing the same function as desired.

9. Claims 35-37 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kimura (5,226,090) in view of Brant et al. (5,970,457).

Regarding claims 35-37, Kimura discloses a voice command to remotely control a device (103) via a transmitter (101,17,D1 remote control signal), wherein the claimed voice recording function is met by the speech recognition circuit 15, controller 16, talk switch 12, mode selector switch 13 and microphone M.

Kimura fails to specify the claimed medical equipment. However, Brant teaches the concept of employing voice command to control the medical equipment. Also, as long as the system of the voice command to remotely control a device, controlling any device would not constitute an inventive step but an obvious design choice. It would have been obvious to one of ordinary skill in the art at the time the invention was made to

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employ the claimed system of Kimura to control any device, such as the medical equipment, as taught by Brant, for performing the same function as desired.

The above combination fails to specify the housing of the voice recorder coupled to the caregiver's head. However, Brant teaches the concept employ the headphone since hands free is required for the doctor to perform the surgery. Since it would have been obvious to control the medical equipment, it would have been obvious to one of ordinary skill in the art at the time the invention was made to provide a hands free method, such as couple the housing of the device of Kimura to the caregiver's head, in the above combination for performing the same function as desired and for convenience.

Allowable Subject Matter

10. Claims 12-17 are allowed.

Response to Arguments

11. Applicant's arguments with respect to claims 1-11, 18-34, 38-41 have been considered but are moot in view of the new ground(s) of rejection.

12. Applicant's arguments filed 01/05/04 have been fully considered but they are not persuasive.

Regarding claims 35-37, in response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, Brant teaches the concept of employing voice command to control the medical equipment. Also, as long as the system of the voice command to remotely control a device, controlling any device would not constitute an inventive step but an obvious design choice. It would have been obvious to one of ordinary skill in the art at the time the invention was made to employ the claimed system of Kimura to control any device, such as the medical equipment, as taught by Brant, for performing the same function as desired. Also, claim 35 only mentions the voice recorder and a transmitter to send commands to medical equipment controller. The claims did not claim any detail of the invention. As long as the reference to Kimura shows the claimed feature voice recorder and the transmitter to control a remote device, the reference still meets the claimed feature. Also, the only thing missing here is Kimura fails to specify if the remote device is a medical equipment. Actually, since Kimura already shows a transmitter to control a remote device via voice command, with or without the teachings of Brant, having Kimura to control medical equipment as one of the remote device would not constitute an inventive step but an obvious design choice. Also, the Examiner only using the reference to Brant to show that it is well-known in the art of using voice command to remotely control the medical equipment. Therefore, it would have been obvious to have the

medical equipment as one of the remote device in Kimura. It does not require any modification of the detail of either one of the system of both references.

Conclusion

13. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Nina Tong whose telephone number is 703-305-4831. The examiner can normally be reached on Mon-Wed. (9:30 -8:00).

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Daniel Wu can be reached on 703-308-6730. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Nina Tong
Primary Examiner
Art Unit 2632

Nina Tong
April 16, 2004

A handwritten signature in dark ink, appearing to be 'Nina Tong', with a long horizontal stroke extending to the left.